



MAY 17 2001

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| In re Application of | : | |
| DUBOIS | : | DECISION ON |
| Application No.: 09/194,996 | : | |
| PCT No.: PCT/FR97/01024 | : | RENEWED PETITION |
| Int. Filing Date: 10 June 1997 | : | |
| Priority Date: 11 June 1996 | : | UNDER 37 CFR 1.47(b) |
| Attorney's Docket No.: 146.1309 | : | |
| For: TRANSDERMIC SYSTEMS . . . | : | |
| MEDICAMENTS | : | |

This decision is in response to the third renewed petition under 37 CFR 1.47(b) filed 12 January 2001.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01024, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 04 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee and an unexecuted declaration.

On 20 April 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 20 September 1999, applicants filed a "COMPLETION OF APPLICATION". The submission included, *inter alia*, a petition under 37 CFR 1.47(b); a declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventors; a "Declaration Under Rule 47" by Jean-Claude Vieillefosse (hereinafter "first declaration of facts"); and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

On 14 February 2000, the USPTO mailed a decision dismissing applicant's petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had not been provided: factual proof that the inventor refuses to execute the application; a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 21 March 2000, applicants filed a renewed petition under 37 CFR 1.47(b). The renewed petition was accompanied by a "Supplemental Declaration Under Rule 47" (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse.

On 23 March 2000, applicants filed a "Supplement to the Renewed Petition" accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 26 July 2000, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47(b). Specifically, the decision noted that the following had still not been provided: a statement of the last known address of the inventor; an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor; and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

On 03 August 2000, applicants filed the instant second renewed petition under 37 CFR 1.47(b).

On 14 December 2000, the USPTO mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47(b). Specifically the decision noted that proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had still not been provided.

On 12 January 2001, applicant submitted the instant renewed petition, which was accompanied by a declaration of Jean-Claude Vieillefosse.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached

after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. It was noted in the decision mailed 14 February 2000 that applicant has satisfied items (1) and (6) above. The decision mailed 26 July 2000 noted that applicant has also satisfied item (2). The decision mailed 12 January 2001 indicated that items (3) and (4) had also been satisfied.

In regard to item (5) above, the decision mailed 14 December 2000 noted that, contrary to the second declaration of facts which stated that "Jean-Claude Vieillefosse is an European patent attorney as well as a licensed French patent agent and under French law and Mr. Dubois' employment contract which are of record in the present application with English translation thereof, Mr. Dubois is required to assign all inventions to Hoechst Marion Roussel", there are limitations on inventions which must be assigned. Attention was directed to the English translation of Exhibit B, Art. L. 611-7.

Art. L. 611-7. If the inventor is an employee, the right to the industrial property title, failing a contractual stipulation that is *more favourable to the employee*, is defined according to the following provisions:

1. Inventions made by the employee in the performance, either of a contract of employment comprising an inventive task *which corresponds to his actual duties*, or of studies and research with which he has been explicitly entrusted, belong to the employer. . . . (emphasis added)

Thus, it was noted that the employee must have been performing an inventive task which corresponds to his actual duties or be performing studies and research with which he has been explicitly entrusted for the invention to belong to the employer. As it had not been established that the employee's performance was of such a nature, item (5) had not been satisfied.

The last paragraph of MPEP § 409.03(f) was also reproduced in the event that applicant would have liked to provide a legal memorandum of the type discussed in the two previous decisions.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

It was also noted that any such memorandum should be supported by facts made of record by way

of an affidavit or declaration of the person having firsthand knowledge of the facts.

In response to the decision mailed 14 December 2000, applicant submitted the instant renewed petition accompanied by a declaration of Jean-Claude Vieillefosse. This declaration states that Mr. Vieillefosse knows "of his own personal knowledge that the invention set forth in the above-identified application was an invention made by Mr. Dubois during his time of employment at Hoechst Marion Roussel" and that "the present invention was the result of his employment by Hoechst Marion Roussel falling within the scope of his contract." However, this declaration is insufficient in that it provides no proof that the invention was actually invented during the period of Mr. Dubois's employment with Hoechst Marion Roussel on activities relating to his employment. The statement of Mr. Vieillefosse does not indicate any of the specific details surrounding the present invention of Mr. Dubois, e.g., the nature of the invention, when the invention was made, where the invention was made, the specific relationship of the inventive activities of Mr. Dubois and his employment with Hoechst Marion Roussel. Rather, the declaration mainly makes assertions which are unsupported. Additionally, it is not clear from the declaration whether Mr. Vieillefosse even has firsthand knowledge of such details. The declaration states that it "is made after a review of the record by Mr. Vieillefosse for Hoechst Marion Roussel and it is made on his own personal knowledge as a result thereof." However, it is not clear what is meant by "the record". Since it is not clear what sources Mr. Vieillefosse obtained his information from, it is not clear whether he has firsthand knowledge. Finally, it is noted that the declaration states that "[t]hat the invention was made within the scope of his duties as an employee of Hoechst Marion Roussel as can be seen from his employment contract and the English translation thereof already of record." However, it cannot be seen from the employment contract that the invention was made within the scope of his duties as an employee. Rather, this is what an affidavit should establish.

CONCLUSION

For the above reasons, applicants' second renewed petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)", whichever is appropriate. No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant

Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



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